

APR. 13. 2004 5:22PM

HOWREY SIMON ARNOLD

NO. 0231 P. 49

EXHIBIT E

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NO. 0231 P. 50

EPI-02672



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/093,972	06/09/98	NYCE	J P6641031

HM12/0524

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EXAMINER

EPPS, J

ART UNIT

PAPER NUMBER

1605

35

DATE MAILED: 05/24/01

Appeal Brief due 7/14/01,
5 XT AVAIL.

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Interview Summary	Application No.	Applicant(s)	
	09/093,972	NYCE, JONATHAN W.	
	Examiner Janet L Epps	Art Unit 1635	

All participants (applicant, applicant's representative, PTO personnel):

(1) Janet L Epps. (3) _____.

(2) Viviana Amzel. (4) _____.

Date of Interview: 21 May 2001.

Type: a) Telephonic b) Video Conference
c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.
If Yes, brief description:

Claim(s) discussed: 108-234.

Identification of prior art discussed:

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicants were informed that the newly submitted amendments filed 4-25-01 and 5-04-01 were not in compliance with the amendments that were agreed upon during the interview held 4-24-01. Applicants agreed to file another amendment comprising only the amendments agreed upon 4-24-01.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

**Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews
Paragraph (b)**

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the Interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) An identification of the claims discussed,
- 3) An identification of the specific prior art discussed,
- 4) An identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) A brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) A general indication of any other pertinent matters discussed, and
- 7) If appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Advisory Action	Application No.	Applicant(s)
	09/093,972	NYCE, JONATHAN W.
	Examiner	Art Unit
	Janet L Epps	1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 5-04-01 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) The period for reply expires 6 months from the mailing date of the final rejection.
- b) In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. A Notice of Appeal was filed on 04 May 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
- 3. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) they raise the issue of new matter. (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

- 4. Applicant's reply has overcome the following rejection(s): _____.
- 5. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 6. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
- 7. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 8. For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
 - Claim(s) allowed: 108-115, 118, 121-124, 126-129, 132-134, 136-143, 145-147, 149-157, 160, 161, 163-168, 170-188, 190, 192-205, 207, 209, 212-215, 217, 218 and 221-230.

Claim(s) objected to: _____.

Claim(s) rejected: 116, 117, 119, 120, 125, 130, 131, 135, 144, 148, 158, 159, 162, 169, 189, 191, 206, 208, 210, 211, 216, 219, 220 and 231.

Claim(s) withdrawn from consideration: _____.

- 9. The proposed drawing correction filed on _____ a) has b) has not been approved by the Examiner.
- 10. Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
- 11. Other: _____.


ANDREW WANG
PRIMARY EXAMINER

APR. 13. 2004 5:24PM

HOWREY SIMON ARNOLD

NO. 0231 P. 54

Application NO.

Continuation Sheet (PTO-303)

U.S. Patent and Trademark Office
PTO-303 (Rev. 01-01)

Advisory Action

Part of Paper No. 34

Continuation of 3. NOTE: Applicant's amendment filed 5-04-01 included multiple amendments to the claims that were not agreed upon in the Interview of 4-24-01. Specifically, amendments to claims which involved the broadening of the scope of the claimed invention, for example the amendment to claim 115 wherein the phrase "selected from the group consisting of" was deleted and replaced with the term "comprising." Additionally, claims 116, 117, 119-120, 125, 130, 131, 135, 144, 148, 158-159, 162, 169, 189, 191, 208, 208, 210-211, 216, 219, 220, and 231, were amended to recite transitional language which increased the breadth of the claims beyond the scope of the specification as filed. The newly added amendments would raise new grounds of rejection under 35 USC 112, first paragraph, for the addition of new matter to the claims.